UNITED STATES PATENT AND TRADEMARK OFFICE

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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER
FIELDS, BENJAMIN S

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARK E. PETERS, DAVID RICHARD SHEPHERD,

MARK ALAN SIBERT, and DAVID MARK SOROKA

_____

Appeal 2009-005735
Application 10/675,503
Technology Center 3600

_____

Decided: December 16, 2009

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Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
KEVIN F. TURNER, *Administrative Patent Judges.*

TURNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the rejections of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM[1].

THE INVENTION

Appellants' claimed invention relates to a method for processing mobile commerce transactions and a mobile commerce system which routes payment transactions in a wireless network to mobile server wallets. The mobile server wallets are associated with corresponding subscribers in a wireless service provider network and used for processing the payment transaction. (Spec. 4).

Independent claim 1, which is deemed to be representative, reads as follows:

> 1. A mobile commerce system comprising:
> a plurality of mobile server wallets each wallet having an association with a corresponding subscriber in a wireless service provider network;
> a proxy server disposed in said wireless service provider network; and, [sic]
> a filter plug-in coupled to said proxy server and configured to intercept selected payment messages flowing through the proxy server and to route said

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jun. 11, 2008) and Reply Brief ("Reply Br.," filed Sep. 8, 2008), and the Examiner's Answer ("Ans.," mailed Jul. 7, 2008).

payment messages to selected ones of said mobile server
wallets.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on

appeal is:

Suzuki et al.	US 2002/0032616 A1	Mar. 14, 2002
Steed et al.	US 2002/0107755 A1	Aug. 8, 2002

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being
unpatentable over Suzuki and Steed.

Rather than repeat the arguments of Appellants or the Examiner, we
make reference to the Briefs and the Answer for their respective details.
Only those arguments actually made by Appellants have been considered in
this decision. Arguments that Appellants did not make in the Briefs have
not been considered and are deemed to be waived. *See* 37 C.F.R.
§ 41.37(c)(1)(vii).

ISSUE

Have Appellants shown Examiner erred in rejecting 1-12 under 35
U.S.C. § 103(a) as being unpatentable over Suzuki and Steed?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

Claim Construction

1. The ordinary and customary meaning of "proxy server" is "[a] server located between a client, such as a web browser, and the server the client is trying to contact, and which tried to fulfill the request before sending it to the server."[2]

2. The ordinary and customary meaning of a "plug-in" is "[a] piece of software that installs in a browser. . ."[3]

3. The ordinary and customary meaning of "intercept" is "1) [t]o stop, deflect, or interrupt the progress or intended course of. . ."[4]

4. Appellants' Specification describes that a "profile" can specify a merchant and further can have a configuration for routing the payment messages to the mobile server wallets when a source of the payment messages matches a merchant identity specified in the profiles. (p. 4).

5. The Examiner took Official Notice that, ". . . it is old and well known in the art [of wireless/mobile commerce, etc.] to preferably create a

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[2] (Preston Gralla, How The Internet Works 392 (8th ed. 2007)).
[3] (Preston Gralla, How The Internet Works 392 (8th ed. 2007)).
[4] *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <Dictionary.com http://dictionary.reference.com/browse/intercept>

system that attaches a profile which would correspond to each transaction of a filter plug-in in order to monitor the transactional history of exchanges which occur via the system." (Ans. 5).

Suzuki

6. Suzuki is directed to a relay server on a settlement system which relays payment information between a shopper's terminal device, a shop server, and a wallet server to take a payment. (¶ [0002]).

7. Suzuki discloses that the shopper's terminal device can be a portable cellular phone. (¶ [0002]).

8. Suzuki discloses that the relay server comprises a redirecting section which transfers payment information from the shopper's terminal, to the shop server, and then to the wallet server. (¶ [0017]).

9. Suzuki describes a wallet server as:

> a program used to carry out communication with the wallet software on the wallet server is executed by the user terminal, as an extended program of the Web browser of the user terminal, that is, as plug-in software. By using the plug-in software, the payment information that the user terminal has received from the shop server is transferred from the user terminal to the wallet server. Thereafter, based on the transferred payment information and on the authentication information held by the wallet server, payment procedures are taken between the wallet server and the settlement institution.

(¶ [0009]).

10. Suzuki describes that the wallet server stores personal electronic wallets for each of the users including authentication information required to control the requests for payment processing. (¶¶ [0048] and [0052]).

Steed

11. Steed is directed to a server based electronic wallet system for facilitating purchases from a wireless device. (Abs. and ¶ [0011]).

12. Steed discloses, ". . . a wallet proxy 14, which is software that can run on a server connected to the WAP gateway 12 or on the same server as the WAP gateway 12." (¶ [0020]).

13. Steed discloses that the proxy stores a list of predetermined merchant form URLs and filters the list for wireless devices to access a form from a merchant server. (¶ [0014]).

14. Steed describes wallet proxy software that ". . . when loaded onto a gateway server, cause the gateway server to operate as a proxy that: receives, parses and filters requests from wireless devices. . ." (¶ [0012]).

PRINCIPLES OF LAW

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406

(2007). The question of obviousness is resolved on the basis of underlying
factual determinations including (1) the scope and content of the prior art,
(2) any differences between the claimed subject matter and the prior art, (3)
the level of skill in the art, and (4) where in evidence, so-called secondary
considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See
also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be
reordered in any particular case, the [*Graham*] factors continue to define the
inquiry that controls.")

In *KSR*, the Supreme Court held that "[t]he combination of familiar
elements according to known methods is likely to be obvious when it does
no more than yield predictable results." *KSR*, 550 U.S. at 407. The Court
explained:

> When a work is available in one field of endeavor, design
> incentives and other market forces can prompt variations of it,
> either in the same field or a different one. If a person of
> ordinary skill can implement a predictable variation, § 103
> likely bars its patentability. For the same reason, if a technique
> has been used to improve one device, and a person of ordinary
> skill in the art would recognize that it would improve similar
> devices in the same way, using the technique is obvious unless
> its actual application is beyond his or her skill.

Id. at 417.

The operative question in this "functional approach" is thus "whether
the improvement is more than the predictable use of prior art elements
according to their established functions." *Id.* In rejecting claims under 35
U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima
facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir.
1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only

if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *In re Oetiker,* 977 F.2d at 1445; *see also In re Piasecki,* 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker,* 977 F.2d at 1445; *In re Piasecki,* 745 F.2d at 1472.

In making a rejection, however, an examiner may "take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert,* 424 F.2d 1088, 1091 (CCPA 1970) (*citing In re Knapp-Monarch Co.,* 296 F.2d 230 (CCPA 1961)).

ANALYSIS

Claims 1-12 rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki and Steed[5].

Independent Claims 1, 5, and 9

Appellants generally argue that Suzuki and Steed fail to disclose, teach or suggest, "a filter plug-in coupled to said proxy server and configured to intercept selected payment messages flowing through the proxy server and to route said payment messages to selected ones of said mobile server wallets," as recited in claim 1. Specifically, Appellants argue that the Examiner, ". . . has not established that the plug-in software described by Suzuki has these filtering capabilities." (App. Br. 6).

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[5] Appellants assert that claims 3-12 stand or fall with independent claim 1; and claim 2 stands or falls alone. (App. Br. 4).

We are not persuaded by Appellants' arguments and find that the Examiner cited to Steed to teach a proxy server which receives, parses and filters requests from a wireless device. (FF 12, 14). Additionally, the Examiner cited to Suzuki to teach a filter plug-in coupled to the proxy server (FF 9), which the Examiner interpreted as "plug-in software in order to route messages regarding payment transactions within the system." (Ans. 4).

Notwithstanding the above, the rejection is based on the combination of Suzuki and Steed, and we find that a person of ordinary skill in the art would have been able to use the teaching in Steed, which discloses a proxy server comprising software that operates to parse and filter requests from a wireless device (FF 1, 2, 14), with the relay server taught in Suzuki, which routes payment information from a user's portable cellular phone to a seller using a server wallet for payment (FF 6, 7, 8, 9), in order to "intercept selected payment messages flowing through the proxy server, and to route said payment messages to selected ones of said mobile server wallets," as claimed by Appellants. This modification is nothing more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. *See KSR*, 550 U.S. at 417. Specifically, the modification involves the mere application of a known technique which here is intercepting messages flowing through a proxy server and routing the messages to selected servers. We conclude that this modification would have been obvious to one of ordinary skill in the art the time of the invention and thus appears to be merely a predictable variation of transmitting payment messages to the

selected mobile server wallets disclosed in Suzuki. (FF 8) Accordingly, we find this argument unpersuasive.

With regard to Appellants' argument that the plug-in described by Suzuki does not have the requisite filtering capabilities, we disagree. As discussed *supra*, the system disclosed by Suzuki routes payment information from a user's portable cellular phone to a seller using a server wallet for payment through a relay server. In order for the Suzuki settlement system to operate, the payment information must be routed effectively through the appropriate user's mobile wallet. We find that a router would necessarily filter this payment information in a manner commensurate with the scope of Appellants' independent claim 1. Moreover, the rejection is based on the combination of Suzuki and Steed, and Steed explicitly discloses software which has the requisite filtering capabilities. (FF 14). Thus, the combination of Suzuki and Steed makes obvious the "filter plug-in" of claim 1. Therefore, we find this argument unpersuasive as to error in the rejection.

Appellants additionally argue, "the Examiner has failed to factually establish that Suzuki teaches the claimed plurality of mobile server wallets have an association with "a corresponding subscriber in a wireless service provider network," as claimed." (App. Br. 7). We are not persuaded by Appellants' argument and find that Suzuki describes a payment system which transmits payment information from a user's terminal to a shop's terminal using a wallet server to effectuate payment. (FF 6). Additionally, Suzuki describes that the user terminal may be a portable cellular phone. (FF 7). We find that the portable phone would necessarily be associated with a corresponding subscriber in a wireless service provider network in

order for the portable cellular phone to interact with the communication network and the plurality of personal wallets found on the wallet server. (FF 9, 10). Thus, since Appellants have not provided their own lexicographic definition in the Specification for "association," and given the breadth of the claim, we find the combination of Suzuki and Steed makes obvious "a plurality of mobile server wallets each wallet having an association with a corresponding subscriber in a wireless service provider network," as claimed by Appellants. Therefore, Appellants' argument is not persuasive as to error in the rejection.

Appellants next argue that, "the Examiner's alleged common sense rationale for the proposed combination would not have rendered the combination obvious since the benefits allegedly resulting from this combination are already obtained through the teachings of Suzuki. (App. Br. 8). Specifically, Appellants argue, "Suzuki already teaches the use of an electronic wallet." (App. Br. 8). While we agree with Appellants that both Suzuki and Steed teach the use of an electronic wallet, we are not persuaded by Appellants' argument and agree with the Examiner's rationale for the proposed combination. The Examiner has provided an articulated reasoning with rational underpinning for why a person of ordinary skill in the art would have modified the relaying method and payment system disclosed in Suzuki which transmits payment information from a shopper's terminal (FF 6, 7, 8), with the server-based electronic wallet system of Steed which teaches a proxy server. (FF 14). Thus, a person of ordinary skill in the art would have known this from Steed and applied this technique to Suzuki when processing mobile commerce transactions in a wireless service

provider network. Therefore, Appellants' argument is not persuasive as to error in the rejection.

Claims 6-8 and 10-12

Appellants do not separately argue claims 6-8 and 10-12 depending from claims 1, 5, and 9 respectively, and so have not sustained their burden of showing that the Examiner erred in rejecting claims 6-8 and 10-12 under 35 U.S.C. § 103(a) as unpatentable over Suzuki and Steed for the same reasons we found as to claims 1, 5, and 9, *supra*.

Dependent claims 2 and 3

Claim 2

Appellants argue that Suzuki and Steed fail to teach, suggest or disclose, "a plurality of profiles communicatively linked to said filter plug-in." (App. Br. 8). Additionally, Appellants challenge the Examiner's taking of Official Notice that, ". . . it is old and well known in the art [of wireless/mobile commerce, etc.] to preferably create a system that attaches a profile which would correspond to each transaction of a filter plug-in in order to monitor the transactional history of exchanges which occur via the system." (Reply Br. 8-9). We are not persuaded by Appellants' arguments and find that as discussed *supra*, the combination of Suzuki and Steed teaches a filter plug-in with regard to claim 1. With regard to the profiles linked to the plug-in, as recited in claim 2, Appellants' Specification describes that the profiles can specify a merchant and route the payment messages. (FF 4). Thus, since Suzuki's payment system specifies

merchants and routes payment messages (FF 6, 8, 9, 10), as discussed *supra*, the combination of Suzuki and Steed makes obvious "a plurality of profiles communicatively linked to said filter plug-in." Therefore, Appellants' argument is not persuasive as to error in the rejection.

With regard to the Appellants' challenge of Official Notice, we find that the Examiner did not take Official Notice with regard to the filter plug-in of claim 1, but rather took Official Notice as to the function the filter plug-in performs. Notwithstanding, Appellants' request still fails to specifically point out the supposed errors in the Examiner's taking of Official Notice, including stating why the noticed fact is not considered to be common knowledge or well-known in the art so much as to must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). That has not been done here.

In our view, the Examiner judiciously applied assertions that certain facts are well known or common knowledge in the art by providing a technical line of reasoning underlying the determination of obviousness that is clear and unmistakable. MPEP § 2144.03(B) and (E). We therefore agree with the Official Notice of the Examiner with respect to his findings on attaching a profile which would correspond to each transaction of a filter plug-in. (FF 5). Appellants have not provided any evidence to rebut these findings by the Examiner. Hence, we find no error in the Examiner's use of Official Notice.

Claim 3

Appellants do not separately argue claim 3 depending from claim 2, and so have not sustained their burden of showing that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a) as unpatentable over Suzuki and Steed for the same reasons we found as to claim 2, *supra*.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki and Steed.

DECISION

The decision of the Examiner to reject claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki and Steed is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

AFFIRMED

ack

cc:

CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
Steven M. Greenberg
950 Peninsula Corporate Circle

Suite 3020
Boca Raton, FL 33487